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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,121	10/30/2000	Jerome Aucouturier	746200-000062	5877

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EXAMINER

EWOLDT, GERALD R

ART UNIT PAPER NUMBER

1644

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,121

Applicant(s)

Aucouturier et al.

Examiner

G.R. Ewoldt

Art Unit

1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 4, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above, claim(s) 1-18 and 21-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 20, and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 17 6) ☐ Other:

DETAILED ACTION

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. The response, filed 11/14/02, has been entered.

2. Claims 1-18 and 21-29 stand withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions.

Claims 19-20 and 30-32 are being acted upon.

3. In view of Applicant's Remarks, filed 11/04/02, all previous rejections have been withdrawn.

4. The following are new grounds of rejection.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 19-20 and 30-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 3,678,149 (1972).

The '149 patent teaches a method providing an adjuvant effect to a vaccine comprising at least one antigen or at least one *in vivo* generator of a compound comprising an amino acid sequence comprising combining said antigen or *in vivo* generator with a surfactant or with a mixture of surfactants, said surfactant or mixture of surfactants having an overall HLB number of between 5 and 15, wherein said vaccine is suitable for application mucosally, orally, nasally, rectally or vaginally. (see column 2, EXAMPLE 1). Note that the chosen species, mannitan oleate, is also disclosed in the Chemical Abstracts Registry file as mannide oleate.

The reference clearly anticipates the claimed invention.

7. Claims 19-20 and 30-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Perlaza et al. (1998).

Perlaza et al. teaches a method providing an adjuvant effect to a vaccine comprising at least one antigen or at least one *in vivo* generator of a compound comprising an amino acid sequence comprising combining said antigen or *in vivo* generator with a surfactant or with a mixture of surfactants, said surfactant or mixture of surfactants having an overall HLB number of between 5 and 15, wherein said vaccine is suitable for application mucosally, orally, nasally, rectally or vaginally. (see page 3423, **Immunization**). Note that the chosen species, mannitan oleate, is also disclosed in the Chemical Abstracts Registry file as mannide oleate which is the adjuvant component of Montanide.

The reference clearly anticipates the claimed invention.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 19-20 and 30-32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 10 is indefinite in its recitation of a method that does not clearly set forth method steps. Note that the method comprises "providing an adjuvant effect" or "enhancing an immune response," methods that would presumably occur *in vivo*, however, the claims recite no step of actually administering the composition of the claims to a subject. Thus, it is unclear how the claimed effect or response would be accomplished.

10. No claim is allowed.

11. The method of Claim 20 appears to be free of the prior art.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone numbers are 703-872-9306 (before final) and 703-872-9307 (after final).



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Patent Examiner
Technology Center 1600
January 14, 2003